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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,146	03/08/2005	Joanna Ng	CA920020070US1	9541
76046 7590 04/15/2008 KUNZLER & MCKENZIE 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111				
EXAMINER				
BUL, BRYAN P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/527,146

**Applicant(s)**

NG ET AL.

**Examiner**

BRYAN P. BUI

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 13, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
- Paper No(s)/Mail Date NONE.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This is responsive to Applicant's Election with traverse regarding to "Lack of Unity" made on the original Application No. 10/527146 filed on February 08, 2008 claiming priority from PCT Application PCT/GB03/04238 filed on October 01, 2003 claiming priority from Foreign Application (CANADA) 2406569 filed on October 04, 2002.

2. Applicant's election with traverse of Group I (claims 1-5, 13, 18 and 19) in the reply filed on 02/08/2008 is acknowledged. The traversal is on the ground(s) that the common technical feature of Group I and Group II (i.e., *"the provisioning of associated portlets"*) is a special technical feature that defines "a contribution which each of the claimed inventions, considered as a whole, makes over the prior art" (see page 3, paragraph [0004]). This is not found persuasive because the independent claims of the above 2 groups deal with different subject matter and different problems as defined in the previous Office Action, and their only common feature *"the provisioning of associated portlets in a portal server"* represents a well-known, common feature in the field of portal architectures. There remains no common matter, linking the independent claims, which could be considered in relation to any prior art for establishing whether it could be novel and inventive.

The requirement is still deemed proper and is therefore made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b)

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if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Status of Claims**

Claims 1-5, 13, 18 and 19 are pending of which claims 1 and 13 are in independent form.

Claims 6-12, and 14-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/GB03/04328 filed on October 01, 2003. The priority date considered for the application is October 04, 2002, which is the filing date of Foreign Application mentioned above.

### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Objections***

5. Claims 18 and 19 are objected to because of the following informalities:

The recitation "*the method of any of claims 1 to 11*" refers to non-elected claims 6-11, thus should be changed to "*the method of any of claims 1 to 5*". Appropriate correction is required. For the purpose of examination, Examiner considers claim 18 is dependent on any of claims 1 to 5.

The recitation "*the portlet application of any of claims 12 to 17*" refers to non-elected claims 12 and 14-17, thus should be changed to "*the portlet application of claim 13*". Appropriate correction is required. For the purpose of examination, Examiner considers claim 19 is dependent on claim 13.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 13, "[A] portlet application" is being claimed. However, it appears that one of ordinary skill in the art would interpret the application as program, per se, not embodied on a medium which would enable the functionality of the program to be realized. As such, claim 13 is non-statutory and rejected under 35 U.S.C 101 as a computer program, per se.

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Claims 18 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Regarding claims 18 and 19, those claims are directed to an article comprising "a computer readable signal bearing medium" and "computer program code means recorded on said medium". However, it appears that one of ordinary skill in the art would interpret an article as software, per se. As such, they are rejected as set forth above.

Moreover, claims 18 and 19 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-5,13,18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by "Portlet Development Guide" Edition 1.1, pp.1-59 issued to Hesmer et al. on January 30, 2002 (hereinafter "Hesmer").

Hesmer discloses:

As to claim 1,

A method of collaboration between a plurality of associated portlets in a portal server, comprising:

A) associating each portlet with a portlet descriptor describing a context name **[The portlet deployment descriptor is an XML document that provides configuration information about the portlet to the portal server. This information includes configuration parameters specific to a particular portlet or portlet application as well as general information that all portlets provide]** (see 2.4 Portlet deployment descriptor on page 7).

B) forming collaboration groups of portlets having corresponding context names, a collaboration group being a subgroup of the group of portlets in a portlet application **[One of more portlets compose a portlet application. Portlet applications provide no code on their own but form a logical group of portlets. Beside this more logical gain, portlets of the same portlet application can also exchange messages]**( see 2.1. Portlets and Portlet Applications on page 6).

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As to claim 2,

said context names define context values (see 3.6. PortletContext: "Attributes" on page 19, *emphasis added*);

each said group of portlets including a master portlet and at least one slave portlet **[In the example used in this document, when a URL link of the BookmarkPortlet (master) is clicked, BookmarkBrowserPortlet (slave) displays the contents of the URL. Both of these portlets are packaged as part of the same portlet application]**(see 2.1. Portlets and Portlet Applications on page 6, *emphasis added*).

As to claim 3,

each said group of portlets share context names in common **[For example, using the context, a portlet can access the portlet log, access context parameters common to all portlets within the portlet application, obtain URL references to resources, or get portlet services]** (see 3.6. PortletContext on page 19).

As to claims 4,

communicating changes in context values of a master portlet to slave portlets of said master portlet **[MessageEvents are useful when changes in one portlet should be reflected in another one. For example, clicking a link in our bookmark portlet could show the web page in a bookmark browser portlet]** and **[Broadcast messages: Messages sent to all portlets of the**



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**same portlet application remaining on the same page]** (see 5.1.3. **Message events** on pages 33-34).

As to claim 5,

changing context values of said slave portlets to match context values of said master portlet as communicated **[To achieve this, the links in the bookmark browser must not point to the web site anymore but trigger a “browse” action containing the link. So the ActionListener gets the “browse” action and sends a message to the browse portlet]** (see page 34).

As to claim 13, Hesmer also discloses:

A portlet application capable of operating on a portal server for hosting multiple associated portlets in a web portal accessible by a user, said portal server providing messaging means (MessageEvents) for allowing said associated portlets to message each other **[portlet applications of the same portlet application can also exchange messages]** (see 2.1 on page 6, *emphasis added*), comprising:

portlet application means for managing said multiple associated portlets **[The portal server provides a framework of services to make the task of writing and managing portlets easier]** (see 2. Overview on page 5);

each associated portlet having a portlet descriptor describing context names (see 2.4. Portlet deployment descriptor on pages 7);

said associated portlets comprising collaboration groups of portlets having corresponding context names defining context values (see 3.6. PortletContext on page 19);

each said group of portlets comprising a master portlet and at least one slave portlet (see 2.1. Portlets and Portlet Applications on page 6);

wherein each said group of portlets share context names in common **[context parameters common to all portlets within the portlet application]** (page 19);

means in said portal server for broadcasting communicating changes in context values of a master portlet to slave portlets of said master portlet **[Broadcast messages: Messages sent to all portlets of the same portlet application remaining on the same page]** (see page 34);

means in said portal server for changing context values of said slave portlets to match context values of said master portlet as broadcast **[To achieve this, the links in the bookmark browser must not point to the web site anymore but trigger a “browse” action containing the link. So the**

**ActionListener gets the “browse” action and sends a message to the browse portlet]** (see page 34).

As to claim 18, it is an article claim corresponding to any method of claims 1-5. Since it does not teach or define above the information in the corresponding method claims, it is rejected under same rationale.

As to claim 19, it is an article claim corresponding to application claim 13. Since it is similar in scope with claim 13, it is rejected under same rationale.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jolley et al. (US Pat No. 7,240,280 B2)

Jones et al. (US Pat No. 7,103,844 B2)

Fletcher et al. (US Pat No. 6,985,939 B2)

Anuff et al. (US Pat. No. 6,327,628 B1)

Belt et al. (US PGPub No. 2003/0187956 A1)

Schaeck (US PGPub No. 2002/0169852 A1).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Bui whose telephone number is (571)-270-1981. The examiner can normally be reached on Monday-Friday from 7:30

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am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)-272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from USPTO Customer Service Representative or access to the automated information system, call 1-(800)-786-9199 (in U.S.A or Canada) or 1-(571)-272-1000.

BB

/Glenton B. Burgess/

Supervisory Patent Examiner, Art Unit 2153